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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,634	12/01/2000	Makoto Miyazawa	Q61929	8039

7590 12/12/2002

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EXAMINER

MARKHAM, WESLEY D

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 12/12/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,634

Applicant(s)

MIYAZAWA, MAKOTO

Examiner

Wesley D Markham

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Acknowledgement is made of applicant's amendment C, filed as paper #15 on 10/2/2002, in which Claim 1 was amended, and Claims 13 and 14 were added. Claims 1 – 5 and 11 – 14 are currently pending in U.S. Application Serial No. 09/701,634, and an Office Action on the merits follows.

Claim Objections

2. The objection to Claim 1, set forth in paragraph 3 of the previous Office Action (i.e., the non-final Office Action, paper #14, mailed on 7/2/2002), is withdrawn in light of applicant's amendment C.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The rejection of Claims 2 and 5 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, set forth in paragraph 6 of the previous Office Action, is withdrawn in light of applicant's amendment C.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 – 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (JP 09-99444 A) in view of Logan et al. (USPN 4,711,035), in further view of Wood et al. (USPN 5,053,971), and in further view of either Blomberg et al. (USPN 6,242,065 B1) or the applicant's admitted prior art (AAPA) as set forth in paragraphs 10 – 13 of the previous Office Action and below.
7. Please note that amended independent Claim 1 (from which Claims 2 – 5 and 11 depend) further requires that the edging mark or line “functions as a boundary for appearance inspection”. This limitation is not explicitly taught by the aforementioned combination of references. However, Logan et al. teach that the optical industry generally produces a pattern having the size and shape of a lens opening in an eyeglass frame for use as a guide in an edge grinding and contouring apparatus to peripherally edge grind the optical lens to the size and shape of the lens opening. The shape of the lens opening is transferred to the surface of the lens blank by tracing the outline of the inner periphery of the lens opening with a marker. The blank is then cut following the outline on the blank surface to form a pattern corresponding to the associated traced lens opening (Col.1, lines 15 – 30). In other

words, the edging outline taught by Logan et al. "functions as a boundary" between the portion of the lens blank which forms the lens and the portion of the lens blank that is cut-off. Since the lens is cut following the outline of the blank surface, it would have been obvious to one of ordinary skill in the art to look at (i.e., inspect) the edging line in order to insure that the lens is cut to the appropriate size and shape (i.e., by following the edging outline) as desired by Logan et al. As such, the edging line of Logan et al. "functions as a boundary for appearance inspection" as required by the applicant's claims. In the alternative, the combination of Kato, Logan et al., Wood et al., and either Blomberg et al. or the AAPA teaches all the process steps and limitations of the applicant's claims, including marking an edging line on the surface of a spectacle lens, the edging line corresponding to spectacle frame openings. Although the prior art references do not explicitly teach that the edging line "functions as a boundary for appearance inspection", the edging line itself which is reasonably suggested by the prior art is equivalent to the applicant's claimed edging line. Therefore, the edging line of the prior art inherently functions as a boundary for appearance inspection as required by the applicant's claims. Please note that the fact that applicant has recognized another advantage (i.e., that only the region inside the edging mark / line needs to have its quality guaranteed) which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Importantly, please note that the applicant's claims only require that the edging line function as a boundary

for appearance inspection; no actual "appearance inspection" step (i.e., in which only the area inside the edging line is inspected) is required by the applicant's claims.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (JP 09-99444 A) in view of Logan et al. (USPN 4,711,035), in further view of Wood et al. (USPN 5,053,971), in further view of either Blomberg et al. (USPN 6,242,065 B1) or the applicant's admitted prior art (AAPA), and in further view of Komatsu et al. (JP 06-191159 A) as set forth above in paragraph 7 and in paragraphs 14 – 15 of the previous Office Action.
9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (JP 09-99444 A) in view of Logan et al. (USPN 4,711,035), in further view of Wood et al. (USPN 5,053,971), and in further view of either Friedman (USPN 6,159,397) or the applicant's admitted prior art (AAPA).
10. The combination of Kato, Logan et al., and Wood et al. teaches all the limitations of Claim 13 as set forth above in paragraphs 6 – 7, paragraph 11 of the previous Office Action, and paragraph 12 of the final Office Action (paper #8), except for a method wherein, after the marking step, a dyeing step of dyeing the spectacle lens is carried out, after which the edging mark remains on the spectacle lens. Specifically, while the combination of Kato, Logan et al., and Wood et al. suggests the applicant's claimed marking and edging steps (see paragraphs 12 – 13 of paper #8), the

combination is silent as to intermediate lens processing steps that take place between the marking and edging steps. However, Friedman teaches that, in the art of producing a spectacle lens (Col.2, line 49), it is conventional to perform a lens dyeing step prior to edging the lens to a desired shape so as to fit the shape and size of an eyeglass frame (Col.2, lines 38 – 46). In addition, the AAPA teaches that a known process for producing a spectacle lens includes the step of dyeing the lens prior to edging the lens (see Figure 5, description in the “Background Art” section of the specification, and page 10, lines 13 – 15). It would have been obvious to one of ordinary skill in the art to dye the lens of the combination of Kato, Logan et al., and Wood et al. prior to edging the lens with the reasonable expectation of (1) success, as both Friedman and the AAPA teach that that such a process was known in the art at the time of the applicant’s invention, and (2) obtaining the benefits of dyeing the lens, such as producing a lens having a desired color or tint (i.e., color or tint being a simple question of aesthetics). As both Friedman and the AAPA suggest performing these steps prior to lens edging (i.e., which is the step in which the edging marks / line of the prior art is cut-off), the edging mark would have remained on the spectacle lens after the dyeing step, as required by the applicant’s claim.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (JP 09-99444 A) in view of Logan et al. (USPN 4,711,035), in further view of Wood et al. (USPN 5,053,971), in further view of either Friedman (USPN 6,159,397) or the

applicant's admitted prior art (AAPA), and in further view of Elias et al. (USPN 4,915,986).

12. The combination of Kato, Logan et al., Wood et al., and either Friedman or the AAPA teaches all the limitations of Claim 14 as set forth above in paragraph 10, except for a method wherein the dyeing step is a gradation dyeing step. Specifically, both Friedman and the AAPA are silent as to the particulars of the dyeing step. However, Elias et al. teach that, in the art of producing eyeglass lenses (Abstract), it was known at the time of the applicant's invention to either solidly, uniformly tint the lenses or to gradient tint (i.e., gradation dye) the lenses (Abstract and Col.1, lines 5 – 17). Therefore, it would have been obvious to one of ordinary skill in the art to gradation dye the lenses of the combination of Kato, Logan et al., and Wood et al. with the reasonable expectation of (1) success, as Elias et al. teach that such a process was known in the art at the time of the applicant's invention, and (2) obtaining a lens having a desirable aesthetic quality (i.e., a gradient tint). Whether the lenses would be solidly tinted or gradation dyed is a question of aesthetics that would be determined by a purveyor in the art depending on the desired appearance of the finished lens.

Response to Arguments

13. Applicant's arguments filed on 10/2/2002 have been fully considered but they are not persuasive.

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14. First, the applicant argues that none of the applied references teach that the edging mark functions as a boundary for appearance inspection. The examiner has addressed this argument in paragraph 7 above.
13. Second, the applicant argues that none of the references disclose or suggest that the edging mark remains on the spectacle lens after the step of polishing, dyeing, hard coat formation, and anti-reflection coating formation. In response, the test of obviousness is not an express suggestion of the claimed invention in any or all references, but rather what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them (*In re Rosselet*, 146 USPQ 183). The cited references, taken collectively, reasonably suggest that the edging mark remains on the spectacle lens after the step of dyeing, hard coat formation, and/or anti-reflection coating formation. Specifically, Blomberg et al., Friedman, and the AAPA all suggest performing the aforementioned steps prior to lens edging (i.e., which is the step in which the edging marks / line of the prior art is cut-off). Therefore, the edging mark would have remained on the spectacle lens after the dyeing step, hard coat formation step, and/or anti-reflection coating step.
13. Third, the applicant argues that, since Blomberg et al. is directed toward providing laminated lens products, one of ordinary skill in the art would not have been motivated to combine the teachings of Blomberg et al. with the other references (i.e., which do not relate to laminated lens products). In response, the examiner disagrees. The examiner has simply cited Blomberg et al. to show that it was known in the art to deposit hard coatings and antireflective coatings on a lens blank prior to

performing other lens processing steps such as edging. One of ordinary skill in the art of eyeglass lens making would have readily recognized that the same benefits obtained by depositing a hard coating and an antireflective coating on a lens that is later to be laminated (e.g., such as the lenses taught by Blomberg et al.) would have translated to a lens that is not to be laminated. In other words, the motivation to combine Blomberg et al. with the other references is to provide the lenses of the combination of Kato, Logan et al., and Wood et al. with superior abrasion resistance (i.e., due to the hard coating) and to reduce the amount of reflected light associated with the lenses (i.e., due to the antireflective coating). These benefits would have been obtained regardless of whether the lenses are "laminated" or not.

14. Fourth, the applicant argues that the prior art does not disclose or suggest the claimed dyeing step. The examiner has addressed this argument in paragraphs 10 and 12 above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

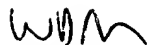
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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (703) 308-7557. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



WDM

December 9, 2002

Wesley D Markham
Examiner
Art Unit 1762



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